

claim 33 is directed to a combination of elements which were not prosecuted in the parent application which led to U.S. Patent No. 5,982,853. In particular, claims 33 calls for a system having a receiver for receiving spoken words and phrases, means for translating the spoken words and phrases into a visual form which may be observed by a hearing impaired person, which translating means includes means for transforming said spoken words into equivalent signing content and then into textual material, and *means for outputting said textual material for display on a device utilized by said hearing impaired person (emphasis added)*. The claim goes on to say that the device utilized by the hearing impaired person including means for receiving words and phrases from the hearing impaired person and that the transforming means converts the words and phrases from the hearing impaired person into a form which may be presented to a hearing person. The claim also calls for means for outputting the translated words and phrases from the hearing impaired person.

The limitation directed to means for outputting the textual material for display on a device utilized by the hearing impaired person is a limitation which was not prosecuted in the parent case and thus claim 33 is not an attempt to recapture subject matter surrendered during the prosecution of the parent application. Rather, it is

directed to a combination of elements which was not prosecuted in the parent case.

The combination of elements set forth in claim 33 also differs from the previously prosecuted claims in that the video apparatus, which had been previously claimed in the system claims, has been omitted. After issuance of the patent, Applicant realized that his novel and unobvious electronic communications system did not have to include the claimed video apparatus. Thus, a substantial error had been made during the prosecution of the claims in the original application. Under the broadening provisions of 35 U.S.C. §251, Applicant is entitled to remove this limitation from the claims and obtain a patent to claims having a combination of elements without this feature. The whole purpose of 35 U.S.C. §251 is to allow an applicant to claim material that he invented and disclosed, but failed to inadvertently claim in his issued patent. Thus, absent any rejection on other grounds, Applicant is entitled to claim 33 and its dependent claims 34 - 45.

With regard to the objection under 37 C.F.R. 1.172(a), attached hereto is a consent from the assignee of the patent.

With regard to 37 C.F.R. 1.178, Applicant will surrender the original patent in due course.

With regard to new claim 46, in Applicant's opinion, this claim is allowable because Examiner has not applied any art rejections against any of the claims.

The instant application is believed to be in condition for allowance. Such allowance is respectfully solicited.

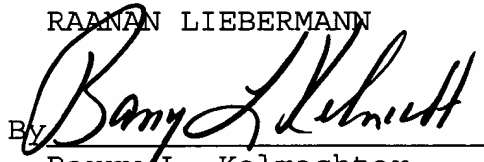
Should the Examiner believe an additional amendment is needed to place the case in condition for allowance, she is invited to contact Applicant's attorney at the telephone number listed below.

A check in the amount of \$51.00 is enclosed herewith to cover the cost of the extra independent claim. Should the Commissioner determine that an additional fee is due as a result of this response, the Commissioner is hereby authorized to charge said fee to Deposit Account No.

02-0184.

Respectfully submitted,

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Date: May 19, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on May 19, 2003.


Nicole Motzer